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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Worth Funding, Incorporated

Serial No. 76/030,894

Cynthia Clarke Weber of Sughrue Mion, PLLC for Worth
Funding, Incorporated.

Elliott S.A. Robinson III, Trademark Examining Attorney,
Law Office 108 (David Shallant, Managing Attorney).

Before Walters, Chapman and Wendel, Administrative
Trademark Judges.

Opinion by Wendel, Administrative Trademark Judge:

Worth Funding, Incorporated has filed an application
to register the mark WORTH FUNDING for "mortgage services,
namely, banking, lending and brokerage mortgage services."¹

Registration has been finally refused under Section

¹ Serial No. 76/030,894, filed April 20, 2000, claiming a first
use and first use in commerce date of April 1, 1999. A
disclaimer has been made of the word FUNDING.

2(d) of the Trademark Act on the ground of likelihood of confusion with the mark WORTH ONLINE, which is registered, inter alia, for "computer services, namely, providing financial information via a global computer network."²

The refusal has been appealed and applicant and the Examining Attorney have filed briefs. No oral hearing was requested.

We make our determination of likelihood of confusion on the basis of those of the *du Pont*³ factors that are relevant in view of the evidence of record. Two key considerations in any *du Pont* analysis are the similarity or dissimilarity of the respective marks and the similarity or dissimilarity of the services with which the marks are being used. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976); *In re Azteca Restaurant Enterprises, Inc.*, 50 USPQ2d 1209 (TTAB 1999).

Looking first to the marks, the Examining Attorney takes the position that WORTH is the dominant portion of both applicant's and registrant's mark, the remaining term in each mark, i.e., FUNDING and ONLINE, being descriptive of the nature of the respective services. He argues that

² Registration No. 2,140,060, issued March 3, 1998. A disclaimer has been made of the word ONLINE.

³ *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

because of the common format of the marks, with the term WORTH being used as the source indicator in each, the marks create similar commercial impressions.

Applicant insists that the marks must be considered in their entirety and that it is the additional wording beyond the common term WORTH which serves to distinguish the marks one from another. Applicant argues that the marks taken as a whole have different meanings related specifically to the particular services involved.

Applicant further argues that registrant's mark is a weak mark entitled only to a narrow scope of protection in view of the general relevance of the term "WORTH" to the financial field and its specific suggestiveness in connection with registrant's services. As evidence in support of its argument of weakness, applicant has introduced copies of several third-party registrations for "WORTH" formative marks for financial services and related goods. Applicant insists that because the common term WORTH is highly suggestive, and the additional term in each mark is descriptive of the particular service involved, the marks should be allowed to coexist for their "specific niche service."

While the marks must be considered in their entirety, there is nothing improper, under appropriate

circumstances, in giving more or less weight to a particular portion of a mark. See *In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). Although descriptive or disclaimed matter cannot be ignored in comparing the marks, it is also a fact that purchasers are more likely to rely on the non-descriptive portion of a mark as an indication of source. See *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993).

We agree with the Examining Attorney that the dominant portion of both applicant's and registrant's marks is the term WORTH. The terms FUNDING and ONLINE, which have been acknowledged as being descriptive by disclaimer thereof, would be more likely to be viewed by purchasers as indicative of the type of services involved than as an indication of source. While applicant has argued as to the different connotations for the marks as a whole based on the descriptive terms, we find the interpretations advanced by applicant for the marks to be strained.

Instead we are convinced, as argued by the Examining Attorney, that the term WORTH alone would be viewed as the source indicator when used in the format employed by both applicant and registrant. Here the term WORTH is used as the first of two terms, and as such, would be the portion

of the mark most likely to be impressed on the minds of purchasers and remembered. See *Presto Products Inc. v. Nice-Pak Products Inc.*, 9 USPQ2d 1895 (TTAB 1988).

Even more significantly, in contrast to the third-party marks relied upon by applicant, here the term WORTH is not used in a phrase for its obvious literal meaning. The registered marks relied upon by applicant to show the weakness of the term WORTH consist of the marks NET WORTH, WORTH KNOWING, PERSONAL WORTH, MONEY\$WORTH, SMITH BARNEY FIXED INCOME HIGH NET WORTH and REAL WORTH. All of these marks use the term WORTH in phrases that have readily recognizable connotations standing alone. Neither WORTH FUNDING nor WORTH ONLINE fits into this pattern. While applicant's mark WORTH FUNDING has the potential of being viewed as a phrase referring to property "worth funding," such an interpretation is more obtuse than any of the third-party marks. The term WORTH as used by both applicant and registrant is much more arbitrary in nature. In fact, the term WORTH is equally as likely to be viewed as a surname.

Thus, we do not find registrant's mark to be weak or the term WORTH as used by registrant to be diluted, as argued by applicant. Registrant's mark is entitled to a

full scope of protection and applicant's mark creates a commercial impression highly similar thereto.

Turning to the services, we note as a general principle that it is not necessary that the services of applicant and registrant be similar or even competitive to support a holding of likelihood of confusion. It is sufficient if the respective services are related in some manner and/or that the conditions surrounding their marketing are such that they would be encountered by the same persons under circumstances that could, because of the similarity of the marks used thereon, give rise to the mistaken belief that they emanate from, or are associated with, the same source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993) and the cases cited therein.

Here the Examining Attorney argues that such a relationship exists between the provision of financial information by registrant, which might well include information about mortgage services, and the actual mortgage services provided by applicant. Applicant, on the other hand, contends that just because the services of both may fall under the category of "financial services," they cannot be considered closely related; and that the services

as identified are narrow and specific enough to be distinguished from one another.

In the past, the Board has found a relationship to exist between a publication of the plaintiff and the goods or services of the defendant featured or advertised in that publication, on the basis that purchasers might be likely to assume that the defendant's goods or services originated with, or were endorsed by, or were in some way associated with the plaintiff. See *Conde Nast Publications Inc. v. Vogue Travel Inc.*, 205 USPQ 579 (TTAB 1979) and the cases cited therein. We find a similar relationship to exist here. Registrant's provision of financial information, regardless of the fact that it is restricted to an online service, could well include information with respect to mortgage rates and other facts particularly relevant to the mortgage services of applicant. Although registrant may not be a provider itself of these mortgage services, we are convinced that potential purchasers, upon encountering the actual mortgage services of applicant under the highly similar mark WORTH FUNDING, may well assume that these services are in some way associated with registrant. Clearly the provision of information as to available rates and other relevant financial facts would be an integral part of applicant's services. Accordingly, we find a

sufficient relationship to exist between the services of applicant and registrant as to give rise to the mistaken belief that both are in some way associated with the same source, when similar marks are used in connection therewith.

We can give no credence to applicant's further argument that the class of purchasers which would avail themselves of registrant's online services would be different from those using applicant's mortgage services. In the first place, there is no evidence of record to this effect. Second, we see no reason why the very persons contemplating the use of a mortgage service such as applicant's would not first, and perhaps throughout the process of obtaining a mortgage, make use of an online information service such as registrant's.

Accordingly, in view of the highly similar commercial impressions created by the respective marks, and the relationship found to exist between the services of applicant and registrant, we find confusion is likely.

Decision: The refusal to register under Section 2(d) is affirmed.